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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,869	09/23/2004	Akifumi Nishio	121235	8521

7590 04/10/2007
Oliff & Berridge
P O Box 19928
Alexandria, VA 22320

EXAMINER

ACKUN, JACOB K

ART UNIT	PAPER NUMBER
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3723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/508,869

Applicant(s)

NISHIO ET AL.

Examiner

Jacob K. Ackun Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Deming (5,487,694). All of the claims require at least the use of a bead saw to “process” peripheral portions of a honeycomb structure. See independent claim 1. The bead saw is shown in Fig 1(a) and Fig. 2(a) of the subject application. Thus it would appear that the bead saw described and claimed in the subject application is the same device as a band saw. Deming discloses that the use of a band saw to process peripheral portions of a honeycomb device is conventional. Note Deming at column 1, describing “contouring” of a honeycomb structure.

Should Deming be later deemed not to disclose a bead saw, it would have been obvious in view of Deming to employ a bead saw in the practice of the prior art contouring, in order to provide the known advantages of the band saw, and especially since the band saw is a linear cut-

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off device that is configured similarly to applicants' bead saw. It would also have been obvious in view of the teaching of Deming to provide features of the claims not specifically taught therein, for the purpose of more easily or economically shaping a product.

4. Claims 1-17 and 19-21 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Greven (2003/0121596), Barss (5,837,084), Schwend (3,739,679) and Johnson (4,111,085), all now cited in this office action. Each reference is applied as was Deming above.

5. Applicant's arguments filed 1/19/07 have been fully considered but they are not persuasive. The applicant argues that the band saw of the prior art is not a bead saw. On the other hand, at least the obviousness rejections indicate that it would have been obvious to employ a bead saw to cut the honeycomb body, in view of the prior art teaching to use a band saw to do the same. The applicant also traverses this alternative ground of rejection.

The applicants arguments are unpersuasive, particularly with regard to the obviousness rejections. Applicant has not argued that applicant is the inventor of the bead saw. Accordingly the bead saw is considered to be prior art, just like the band saw. Applicant teaches in the specification of the subject application that the inventive concept is to use a linear cutoff device to cut a honeycomb structural body. Applicant teaches and claims this, as well as teaches and claims a specific type of linear cutoff device, the bead saw. See independent claim 1, that requires a linear cut off device and specifies that it is a bead saw. Since the band saw also appears to be a linear cutoff device within the ambit of applicants teaching, and since the band saw is shown cutting a honeycomb structural body in the applied prior art, the examiner finds that it would have been prima facie obvious to employ a prior art bead saw to cut the same thing.

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The applicants traverse does not include a single argument regarding the advantages of a bead saw over a band saw for cutting the honeycomb structural body. The applicant also does not specify why applicant believes that one of ordinary skill in the art with the knowledge of cutting the honeycomb body with a band saw would not have found it obvious to employ a bead saw. In view of all of the comments above, therefore, the applicants arguments for unobviousness are simply not supported by objective evidence of record. Therefore the examiner has no option but to find that a claim having the scope of claim 1 is clearly within the prior art. For the foregoing reasons the applicants arguments are rejected.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

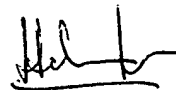
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3723

J.A.